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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,031	06/25/2001	Kenneth H. Tarbet	4189-00500	7507
30652 7590 10/17/2008 CONLEY ROSE, P.C. 5601 GRANITE PARKWAY, SUITE 750 PLANO, TX 75024				
EXAMINER ALAM, SHAHID AL				
ART UNIT 2162		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/888,031

Applicant(s)

TARBET, KENNETH H.

Examiner

Shahid Al Alam

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 9, 10 and 16 - 25 is/are pending in the application.
- 4a) Of the above claim(s) 26-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 9, 10 and 16 - 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 7, 9, 10, 16 – 25 are pending in this Office action.
2. Claims 1 – 6, 8 and 11 – 15 are canceled.
3. Claims 26 – 32 are withdrawn from consideration.

Response to Arguments

4. Applicant's arguments filed July 30, 2008 have been fully considered but they are not persuasive.
5. Applicant's main argument is that Claim 7 is not anticipated by Deaton and that Deaton does not teach the "real time generation and provision of a customer incentive report remote from a point of sale."

Examiner respectfully disagrees all of the allegations as argued. Examiner, in his previous office action, gave detail explanation of claimed limitation and pointed out exact locations in the cited prior art.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111 [R-1]

Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

In response to Applicants' argument that Deaton reference does not anticipate the claimed invention and/or Deaton does not disclose claimed limitations in the cited section (cited location has nothing to do with applicant's invention). Examiner likes to point out that in the "Schering Corp. v. Geneva Pharmaceuticals Inc., 64 USPQ2d 1032 (DC NJ 2002) Decided August 8, 2002."

In the above case it is concluded that the prior art **disclosure need not be express in order to anticipate**. Even if a prior art inventor does not recognize a function of his or her process, the process can anticipate if that function was inherent. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and **that it would be so recognized by persons of ordinary skill. Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art.** Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Insufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation.

In response to applicants' argument the Examiner respectfully submits that Deaton teaches Customer incentive report as, the system generates coupons or issue incentives to induce that higher level of performance by the customer. The performance of a customer is tracked and incentives are modified based upon the criteria of performance such that incentives are added or subtracted (column 71, lines 26 – 30).

Deaton's transaction terminals 120 are each located at a point-of-sale (such as a grocery store checkout stand). Transaction terminals 120 are used to communicate information to transaction processor 112 for check transaction processing and customer database management. A transaction terminal transmits a request (including a function code identifying the requested function together with other request data) to the transaction processor, which processes the request and returns an appropriate response. Deaton, further, teaches prior credit verification systems that requires connecting a point-of-sale terminal through telephone lines to a remote transaction processing system similar to remote from a point of sale or KIOSK as argued and as claimed by the Applicant. The system and method of the invention also provides automatic targeting of individual customers based upon their shopping history. Thus, at the point-of-sale and remote location, coupons or other incentives (**reports**) may be generated (in **real time**) which are specifically targeted to a specific customer based upon his or her prior history.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is not clear because steps in claim do not produce any results of the preamble.

Claim 7, last limitation teaches "fashioning the third table with the identifier".

It is unclear as to what the fashioning the third table had to do with functionality of this invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 9, 10 and 16 – 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,649,114 issued to David Deaton et al. ("Deaton").

With respect to claim 7, Deaton teaches method of improving customer loyalty via real time generation and provision of a customer incentive report from a point of sale (column 4, lines 54 – 61), said method comprising:

utilizing a computer to execute a plurality of steps, the steps comprising (see Figs. 2, 10A, Deaton);

selecting a product information related to product (see col. 68, lines 43-45, Deaton);

storing a purchase information related to the purchase of the product by a customer (see col. 68, lines 45-55, Deaton);

storing a customer information related to the customer, the customer information associating the customer with the purchase (see col. 69, lines 9-20 et seq, Deaton);

storing a promotion information related to a promotion of the product, the promotion being independent of the customer information, wherein the promotion information includes both current and future promotion incentives (column 90, lines 36 – 50 and column 120, lines 12 – 29);

determining an intersection of the promotion information, the purchase information, and the customer information and storing the intersection in a database as the customer incentive report (see col. 90, lines 36-50, Fig. 35, Deaton);

wherein the database comprises a first table containing the product information second table comprising the purchase information, and a third table comprising the promotion information and a reference to a row of at least one table in the database (see col. 93, lines 5-35, Fig. 38, Deaton); and,

following the determining step (see Figs. 10A, 35, Deaton)) step:
fashioning the second table responsive to an item identifier attribute of the first table (see col. 104, lines 20-24, Deaton); and
picking at least one row from first table (see col. 100, lines 10-25, Deaton); and,
receiving an identifier of a first input table comprising at least a portion of one of the first tables, the first input table comprising a plurality of rows, at least one row consisting of at least one selected from an item effective identifier and a user effective identifier (see col. 100, lines 10-25, Deaton); and
fashioning the third table with the identifier (see col. 104, lines 20-24, Deaton).

As to claim 9, Deaton teaches the delivery step comprises delivery of a computer-readable copy of the customer incentive report to the corresponding user (column 118, lines 28 – 35).

As to claim 10, Deaton teaches the delivery step comprises delivery of a printed copy of the customer incentive report to the corresponding user (see col. 118, lines 28-35, Fig. 17A and B, Deaton).

As to claims 16 – 19, the computer readable copy of the customer incentive report includes current incentive offers, future incentive offers, or a combination thereof, the offers disclose pricing and wellbeing information (column 118, lines 28 – 38 and column 119, lines 4 – 50).

As to claims 20 – 23, the printed copy of the customer incentive report includes current incentive offers, future incentive offers, or a combination thereof, the offers disclose pricing and wellbeing information (column 118, lines 28 – 38 and column 119, lines 4 – 50).

As to claim 24 and 25, customer incentive report includes customer loyalty program information (column 7, lines 31 – 50).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shahid Al Alam/
Primary Examiner, Art Unit 2162

October 12, 2008